

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8

APPLICANTS: Prayaga *et al*

SERIAL NUMBER: 10/083,919

EXAMINER: Not Yet Assigned

FILING DATE: February 27, 2002

ART UNIT: 1645

TITLE: ENDOZEPINE-LIKE POLYPEPTIDES AND POLYNUCLEOTIDES
ENCODING SAME

Box DAC
 Commissioner for Patents
 Washington, D.C. 20231

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OFFICE OF PETITIONS

**PETITION FOR FILING PATENT APPLICATION
WHEN AN INVENTOR REFUSES TO EXECUTE UNDER 37 C.F.R. § 1.47(a)**

1. Pursuant to 35 U.S.C. § 116 and 37 C.F.R. § 1.47(a), the undersigned hereby petitions to allow each of the signing inventors to make application on his or her behalf as well as on behalf of the nonsigning joint inventor, Kumud Majumder.
2. The inventors of the invention claimed in the above-referenced application are Sudhirdas K. Prayaga, Richard A. Shimkets, Kumud Majumder, Andrew Eisen, Corine Vernet, Steven K. Spaderna, Jason Baumgartner, Linda Gorman, Vladimir Gusev, Muralidhara Padigaru, Meera Paturajan, Velizar Tchernev, and Li Li, as identified in the unexecuted Combined Declaration and Power of Attorney that was submitted at the time this application was filed. Co-inventor Kumud Majumder refuses to execute the Combined Declaration and Power of Attorney for this application. As required, Applicants enclose herewith copies of counterparts of the Combined Declaration and Power of Attorney form executed by the other co-inventors.
3. Curagen Corporation was the employer of Kumud Majumder (as well as the other co-inventors), at the time the invention, claimed in the present application (U.S.S.N. 10/083,919), which claims priority to U.S.S.N. 09/679,460, filed October 4, 2000, U.S.S.N. 09/679,740, filed October 5, 2000, U.S.S.N. 60/157,786, filed October 5, 1999, U.S.S.N. 60/164,164, filed November 9, 1999, U.S.S.N. 60/174,505, filed January 4, 2000, U.S.S.N. 60/183,859, filed February 22, 2000, U.S.S.N. 60/190,740, filed March 20, 2000, U.S.S.N. 60/191,133, filed March 22, 2000, U.S.S.N. 60/206,006, filed May 19, 2000, U.S.S.N. 60/215,684, filed June 30,

2000, U.S.S.N. 60/219,490, filed July 20, 2000, U.S.S.N. 60/227,072, filed August 22, 2000, and U.S.S.N. 60/271,909, filed February 27, 2001, was conceived and reduced to practice. A copy of a CuraGen Corporation employment agreement executed by Kumud Majumder on October 20, 1997, is attached to this petition. Under this agreement Kumud Majumder is obligated to execute any and all applications for domestic and foreign patents covering inventions conceived, made, or discovered during the course of his employment.

4. A Notice to File Missing Parts for this case was mailed on April 22, 2002. No executed Combined Declaration and Power of Attorney was received from Kumud Majumder. Follow-up correspondence from a colleague of the undersigned to CuraGen Corporation did not result in receipt of an executed Combined Declaration and Power of Attorney from Dr. Majumder. Subsequently, the undersigned was informed that CuraGen Corporation was unable to obtain the executed document from Dr. Majumder.

5. Attached are copies of correspondence between the undersigned and Dr. Majumder concerning the execution of the Combined Declaration and Power of Attorney in order to satisfy the filing requirements for the present application. On October 25, 2002, the undersigned sent a letter to Kumud Majumder via certified mail, return receipt requested, to remind him of his obligation to execute any and all applications for domestic and foreign patents under the terms of his employment agreement with CuraGen Corporation. A copy of the patent specification, Official Filing Receipt, unexecuted Assignment, and unexecuted Combined Declaration and Power of Attorney for the above-referenced application were included with this letter. The letter explicitly requested return of all executed documents by November 5, 2002, and further indicated that a failure to respond would be construed as a refusal to execute on Dr. Majumder's part.

6. On October 30, 2002, the undersigned spoke with Kumud Majumder regarding his obligation to execute the documents sent to him on October 25, 2002. During this conversation, and as confirmed in his November 2, 2002 letter to the undersigned, Dr. Majumder only agreed to execute the documents in exchange for considerable compensation for his time.

7. On November 14, 2002, Christopher McCleod, a representative of CuraGen Corporation with signatory authority, communicated to the undersigned's colleagues at Mintz Levin that

representatives of CuraGen Corporation and Dr. Majumder's employment attorney were in the process of discussing Dr. Majumder's proposal in light of a prior-negotiated settlement agreement between CuraGen Corporation and Dr. Majumder that had been agreed upon following Dr. Majumder's separation from CuraGen Corporation. Under this settlement agreement, Dr. Majumder agreed to sign all relevant documents to complete the filing formalities for all applications for domestic and foreign patents covering inventions conceived, made, or discovered during the course of his employment at CuraGen Corporation.

8. On November 18, 2002, Jim Shea of Jackson Lewis, a law firm which represents CuraGen Corporation on employment matters, relayed to the undersigned that he had spoken to Dr. Majumder's employment lawyer on November 6, 2002 regarding Dr. Majumder's obligations under the above-referenced settlement agreement. The following day, November 19, 2002, Jannine Malicki, head of CuraGen Corporation's Human Resources Department, informed the undersigned's colleagues at Mintz Levin that, according to information received from Jim Shea, Kumud Majumder had agreed to sign all relevant documents. However, in a subsequent phone conversation held that same day, Kumud Majumder informed the undersigned that his payment conditions remained as outlined in his letter dated November 2, 2002.

9. Finally, on November 20, 2002, in email correspondence from representatives of CuraGen Corporation to the undersigned's colleague at Mintz Levin, it was communicated that "Kumud has told Jim Shea (Jackson Lewis) that 'no way, I'm not signing'." (*See Exhibit E*).

10. Thus, based upon the record of correspondence to date, Kumud Majumder has refused and continues to refuse to execute the Combined Declaration and Power of Attorney and to make application as a joint inventor of the present application.

11. Under the requirements set forth under 37 C.F.R. § 1.47, the last address of Kumud Majumder known to the undersigned is:

2398 High Ridge Rd.
Stamford, CT 06903

12. Submitted herewith is:

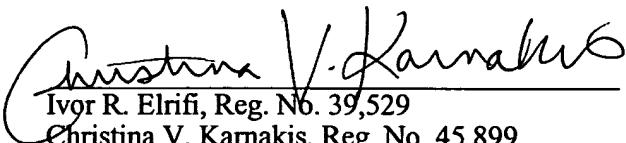
- 12.1 A copy of a written employment agreement between Kumud Majumder and CuraGen Corporation signed October 20, 1997. (Exhibit A)
- 12.2 Combined Declaration and Power of Attorney counterparts executed by co-inventors Sudhirdas K. Prayaga, Richard A. Shimkets, Andrew Eisen, Corine Vernet, Steven K. Spaderna, Jason Baumgartner, Linda Gorman, Vladimir Gusev, Muralidhara Padigaru, Meera Patturajan, Velizar Tchernev, and Li Li. (Exhibit B)
- 12.3 A copy of the October 25, 2002 certified letter from the undersigned to Kumud Majumder requesting execution and return of the Combined Declaration and Power of Attorney for the present application. (Exhibit C)
- 12.4 A copy of the November 2, 2002 letter from Dr. Majumder to the undersigned regarding his proposal for compensation for any time taken to execute these documents. (Exhibit D)
- 12.5 A copy of an e-mail of November 20, 2002 from CuraGen Corporation to the undersigned's colleague relaying Dr. Majumder's express refusal to execute these documents. (Exhibit E)
- 12.6 A check (#14731) in the amount of \$130.00 as required by 37 C.F.R. § 1.17(h).
- 12.7 A copy of the Response to Notice to File Missing Parts filed on November 22, 2002. (Exhibit F)

Based upon the pertinent facts presented herein, the undersigned hereby respectfully requests that application for the above-identified invention be made by each of the signing co-inventors on his or her behalf and on the behalf of the nonsigning co-inventor, Kumud Majumder. To that end, the undersigned, on behalf of the signing co-inventors, respectfully requests consideration and grant of this petition for filing the patent application by less than all of the co-inventors pursuant to 37 C.F.R. § 1.47(a).

Should the Commissioner have any questions concerning this petition, he is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Dated: November 22, 2002


Ivor R. Elrifi, Reg. No. 39,529
Christina V. Karnakis, Reg. No. 45,899
Attorneys for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

*CuraGen Corporation*

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**EMPLOYEE CONFIDENTIAL INFORMATION
AND INVENTION AGREEMENT**

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OFFICE OF PETITIONS

Whereas, Kurnud Majumder (the "Employee") is about to enter or continue in the employ of the CuraGen Corporation, a Delaware corporation having its principal place of business at 555 Long Wharf Drive, New Haven, CT 06511 (the "Company"), and in such employment will or may become informed as to many of its procedural, commercial and technical needs, problems, developments and projects, as well as activities directed thereto,

In consideration of said employment being given or continued and the compensation therein, it is agreed as follows:

PATENTS, COPYRIGHTS AND INTELLECTUAL PROPERTY

1. Employee shall promptly disclose to the Company all Inventions. Inventions shall mean, for purposes of this paragraph, inventions, discoveries, developments, methods and processes (whether or not patentable or copyrightable or constituting trade secrets) conceived, made or discovered by Employee (whether alone or with others) while employed by the Company and that relate, directly or indirectly, to the past, present, or future business activities, research, product design or development, personnel, and business opportunities of the Company, or result from tasks assigned to Employee by the Company or done by Employee for or on behalf of the Company. Employee hereby assigns and agrees to assign to the Company (or as otherwise directed by the Company) his full right, title and interest in and to all Inventions. Employee agrees to execute any and all applications for domestic and foreign patents, copyrights or other proprietary rights and to do such other acts (including, among others, the execution and delivery of instruments of further assurance or confirmation) requested by the Company to assign the Inventions to the Company and to permit the Company to file, obtain and enforce any patents, copyrights or other proprietary rights in the Inventions. Employee agrees to make and maintain adequate and current written records of all Inventions, in the form of notes, sketches, drawings, or reports relating thereto, which records shall be and remain the property of and available to the Company at all times.

2. All designs, ideas, inventions, improvements, and other creations made or owned by Employee before becoming an employee of the Company and which Employee desire to exempt from this Agreement are listed on Attachment A hereof and authorized for exclusion by the signature of an Officer of the Company. (If Employee does not have any such designs, ideas, inventions, improvements, or other creations write "none" on this line: _____.)

3. Employee agrees to notify the Company in writing before Employee makes any disclosure or performs or causes to be performed any work for or on behalf of the Company, which appears to threaten or conflict with (a) rights Employee claims in any invention or idea conceived by Employee or others prior to Employee's employment, or (ii) otherwise outside the scope of this Agreement; or (b) rights of others arising out of obligations incurred by Employee (i) prior to this Agreement, or (ii) otherwise outside the scope of this Agreement. In the event of Employee's failure to give notice under the circumstances specified, the Company may assume that no such conflicting invention or idea exists and Employee agrees that Employee will make no claim against the Company with respect to the use of any such invention or idea in any work which Employee performs or causes to be performed for or on behalf of the Company.

PROPRIETARY AND TRADE SECRET INFORMATION

4. (a) The Employee agrees that he will keep confidential and will not make any unauthorized use or disclosure, or use for his own benefit or the benefit of others, during or subsequent to his employment of any research, development, engineering and manufacturing data, plans, designs, formulae, processes, specifications, techniques, trade secrets, financial information, customer or supplier lists or other information that becomes known to him as a result of his employment with the Company which is the property of the Company or any of its clients, customers, consultants, licensors, licensees, or affiliates, provided nothing herein shall be construed to prevent Employee from using his general knowledge and skill after termination of his employment whether acquired prior to or during his employment by the Company.

(b) Proprietary information subject to paragraph 4(a) does not include information that: (i) is or later become available to the public through no breach of this Agreement by the Employee; (ii) is obtained by the Employee from a third party who had the legal right to disclose the information to the Employee; or (iii) is required to be disclosed by law, government regulation, or court order.

5. During the course of his employment with the Company, the Employee will not accept information from sources outside of the Company which is designated as "Confidential," or "Proprietary," or "Trade Secret" without prior written permission from the Company or its attorneys. The Employee is not expected to and is expressly forbidden by the Company policy from disclosing to the Company "Trade Secret" or "Confidential" or "Proprietary" information from a former employer.

6. During his employment, or upon leaving the employment of the Company, the Employee will not remove from the Company premises, either directly or indirectly, any drawings, writings, prints, any documents or anything containing, embodying, or disclosing any confidential or proprietary information or any of the Company's trade secrets unless express written permission is given by the Company management. Upon termination of his employment, Employee shall return to the Company any and all documents and materials that are the property of the Company or its customers, licensees, licensors or affiliates or which contain information that is the property of the Company.

COMPETITIVE ACTIVITIES

7. (a) While in the employ of the Company and for a period of one year or the maximum period permitted by applicable law (whichever is shorter) following termination of his employment with the Company, Employee shall not, without the approval of the Company, alone or as a partner, officer, director, consultant, employee, stockholder or otherwise, engage in any employment, consulting or business activity or occupation that is or is intended to be competitive with the business of the Company, as being considered, researched, developed, marketed and/or sold at the time of termination; provided, however, that the holding by Employee of any investment in any security shall not be deemed to be a violation of this Section 7 if such investment does not constitute over one percent (1%) of the outstanding issue of such security. This restriction shall run for a period of one year after said termination, and if there shall be any violation hereof during said period, then for a period of one year after cessation of such violation.

(b) While in the employ of the Company, Employee shall promptly notify the Company, if Employee, alone or as a partner, officer, director, consultant, employee, stockholder

or otherwise, engages in any employment, consulting or business activity or occupation outside his employment by the Company.

(c) You agree that you will provide, and that the Company may similarly provide in its discretion, a copy of this Agreement to any business or enterprise which you may directly, or indirectly, own, manage, operate, finance, join, control or in which you participate in the ownership, management, operation, financing, or control, or with which you may be connected as an officer, director, employee, partner, principal, agent, representative, consultant or otherwise.

GENERAL

8. This Agreement shall be binding upon and inure to the benefit of the parties and their respective legal representatives, successors and permitted assigns. The Employee agrees that the Company may assign this Agreement to any person or entity controlled by, in control of, or under common control with, the Company.

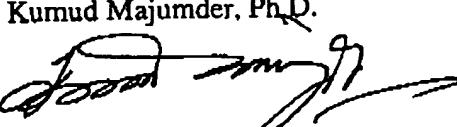
9. This Agreement constitutes the entire agreement between the parties as to the subject matter hereof. No provision of this Agreement shall be waived, altered or canceled except in writing signed by the party against whom such waiver, alteration or cancellation is asserted. Any such waiver shall be limited to the particular instance and the particular time when and for which it is given.

10. This Agreement shall be governed by and construed in accordance with the laws of the State of Connecticut.

11. The invalidity or unenforceability of any provision hereof as to an obligation of a party shall in no way affect the validity or enforceability of any other provision of this Agreement, provided that if such invalidity or unenforceability materially adversely affects the benefits the other party reasonably expected to receive hereunder, that party shall have the right to terminate this Agreement. Moreover, if one or more of the provisions contained in this Agreement shall for any reason be held to be excessively broad as to scope, activity or subject so as to be unenforceable at law, such provision or provision shall be construed by limiting or reducing it or them, so as to be enforceable to the extent compatible with the applicable law as it shall then appear.

IN WITNESS WHEREOF, I have duly executed this Agreement as of this 20th
day of October, 1997

Employee Name: Kumud Majumder, Ph.D.

Employee Signature: 

Address: 5126, JACKWOOD ST.

HOUSTON, TX-77096

Attachment A

① MULTIPLE PURPOSE CLONING (INCLUDING
only those PCR PRODUCTS) VECTOR WITH BACKGROUND
MINIMIZATION ABILITY. TYPICAL EXAMPLES
actually completed before start date
are β KM2B, β KMPLIFY (and so on).

② PORTABLE DEVICES FOR LOCATING CARS,
(AUTOS) OR OTHER VEHICLES AND SO ON.

③ PUNCHING DEVICES THAT PRODUCE
DIRECTLY/INDIRECTLY TEAR RESISTANT
HOLES.

④ PROTEIN EXPRESSION VECTORS USING
HIRUDIN-THROMBIN (OR THEIR DERIVATIVES)
SYSTEMS.

